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TOWNSEND and TOWNSEND and CREW LLP

By

Re: 38,515

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PATENT

Attorney Docket No. 17634-000320

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )

Brian R. Murphy et al. )

Serial No. 09/083,793 )

Filed: May 22, 1998 )

For: PRODUCTION OF ATTENUATED )  
PARAINFLUENZA VIRUS )  
VACCINES FROM CLONED )  
NUCLEOTIDE SEQUENCES )

Examiner: M. Mosher

Art Unit: 1643

PRELIMINARY AMENDMENT AND  
RESPONSE TO  
RESTRICTION REQUIREMENT

Hon. Assistant Commissioner of Patents  
Washington, D.C. 20231

Sir:

This is in response to the Restriction Requirement dated December 22, 1998, which set forth the following groups of claims:

I. Claims 1-47, 94, 97-99, 101, 107-115, 121-128, drawn to polynucleotide encoding the genome of a chimeric parainfluenza virus, mutated parainfluenza virus, or parainfluenza virus comprising heterologous sequence; viruses or particles having chimeric genome or comprising heterologous sequence; and compositions comprising said virus particles, classified in Class 536, subclass 23.72.

II. Claims 48-90, drawn to a method for producing parainfluenza virus using expression vector encoding N, P,

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and L products, and materials used in the method, classified in Class 435, subclass 472.

III. Claims 91-93, 100, 102-106, 116, 118-120, drawn to viruses and subviral particles, classified in Class 435, subclass 235.1.

IV. Claim 95, drawn to infectious parainfluenza virus particle comprising DNA, classified in Class 435, subclass 472.

#### Response to Restriction Requirement

Applicants elect to prosecute group I, claims 1-47, 94, 97-99, 101, 107-115, and 121-128, with traverse.

Applicants respectfully submit that the foregoing restriction requirement be withdrawn, and that the restricted groups of claims identified by the Examiner (with the exception of group IV corresponding to claim 95, cancelled herein) be examined together in the application. In support of this request, Applicants submit that the restricted groups I-III are not so distantly related that a search and examination of all claims could not be made without serious burden on the Office. It is therefore believed that the Examiner should examine groups I-III together on the merits, even though they may be directed to independent and distinct inventions. Furthermore, it is respectfully submitted that the requirement for an election and separate prosecution among the designated groups places an undue burden on Applicant.

If the above requested relief is not provided by the Office, Applicants respectfully request that the Office examine at least groups I and II together on the merits, which groups are directed to polynucleotides encoding a genome of parainfluenza virus, to related constructs and compositions, and to methods for producing said polynucleotides and related constructs and compositions. Contrary to the Office's position stated at page 3 of the Office Action, the products claimed in group I and the

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Preliminary Amendment

Atty. Docket No. 17094-000320

GP1643

Date January 22, 1999

In re application of Brian R. Murphy

Serial No.: 09/083,793

Filed: May 22, 1998

Group Art Unit: 1643

For: PRODUCTION OF ATTENUATED PARAINFLUENZA  
VIRUS VACCINES FROM CLONED NUCLEOTIDE  
SEQUENCES

THE COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

Sir:

Transmitted herewith is a Preliminary Amendment and response to restriction requirement in the above-identified application.

☐ Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.

☒ An Information Disclosure Statement is being submitted under separate cover.

The filing fee has been calculated as shown below:

(Col. 1)		(Col. 2)		(Col. 3)	SMALL ENTITY		OTHER THAN A SMALL ENTITY		
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDIT. FEE	OR	RATE	ADDIT. FEE
TOTAL	* 142	MINUS	** 128	= 14	x9=	\$	OR	14 x18=	\$ 252
INDEP.	* 7	MINUS	*** 7	=	x39=	\$	OR	x78=	\$
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+130=	\$	OR	+260=	\$
					TOTAL	\$	OR	TOTAL	\$ 252

\* If the in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

\*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.  
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

☐ No fee is due.

Please charge Deposit Account No. 20-1430 as follows:

☒ Claims fee \$

☒ Any additional fees associated with this paper or during the pendency of this application.

2 copies of this sheet are enclosed.

TOWNSEND and TOWNSEND and CREW, LLP

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Reg. No.: 38,515  
Attorneys for Applicants